

Remarks

Continuity Data

Applicants have amended the specification to add a reference to the International Application for which this application is a National Stage application, and to reference the U.S. Provisional Application from which the International Application claims priority.

Information Disclosure Statement

Applicants respectfully submit that the Examiner is wrong to assert that the Information Disclosure Statement file on March 12, 2001 fails to comply with the provisions of 37 CFR §§1.97, 1.98 and MPEP § 609. According to 35 CFR §1.97 and reiterated in MPEP § 609, sections (a) and (b) state that:

(a) In order for an applicant for a patent or for a reissue of a patent to have an information disclosure statement in compliance with § 1.98 considered by the Office during the pendency of the application, the information disclosure statement must satisfy *one* of paragraphs (b), (c), or (d) of this section.

(b) An information disclosure statement shall be considered by the Office if filed by the applicant within any one of the following time periods:

(1) Within three months of the filing date of a national application other than a continued prosecution application under § 1.53(d);

(2) Within three months of the date of entry of the national stage as set forth in § 1.491 in an international application;

(3) *Before the mailing of a first Office action on the merits; or*

(4) Before the mailing of a first Office action after the filing of a request for continued examination under § 1.114. [Emphasis added].

In the present case, Applicants respectfully submit that the Information Disclosure Statement filed for this application on March 7, 2001 complies with 37 CFR § 1.97(b)(3) – before the mailing of the first Office action on the merits.

However, nothing in 37 § CFR 1.97 suggests that Applicants must meet the requirements of *both* 1.97 (b)(2) *and* 1.97 (b)(3). In fact, the heading of MPEP § 609(4)(a) says “Information Disclosure Statement Filed *Before First Action on the*

Merits or Within Three Months of Actual Filing Date (37 CFR 1.97(b)) (emphases added). And 37 CFR 1.97(b) specifically states that “An information disclosure statement shall be considered by the Office if filed by the applicant within any *one* of the following time periods: ...” (*see id.*, emphasis added.)

Applicants further note that the Information Disclosure Statement was filed after the national phase has been entered on February 7, 2001. Indeed, the Information Disclosure Statement included the application serial number on present application, as the USPTO had already assigned the serial number prior to the filing of the IDS (as can be seen on the first page of a copy of the IDS attached herewith, minus the references, taken from the File History of the present application and printed from PAIR).

For the reasons stated above, Applicants respectfully submit that the filing date of the IDS for the instant application falls within the time periods set out in CFR § 1.97 (b) (3), so the IDS meets the requirements of CFR § 1.97 (b), and thus meets the requirements of CFR § 1.97 and § 1.98. Applicants therefore request that the IDS, as filed on March 7, 2001, should be considered. 1.491

Amendments to the Claims

Applicants have amended claims 18, 21, 23, 50, and 51, and cancelled claims 1-17, 20, 24-49, 53-54, and 57-85. Claims 18, 50 and have been amended to recited that the sequence is the MAIAP SEQ ID NO: 11, for clarity. Claim 21 has been amended to depend only from claim 18, because claim 20 has been cancelled. Claim 51 has been amended to replace the word “method” with “vaccine”, to match the above antecedent basis in claim 50. Claim 50 has also been amended to recite that the vaccine is for “inducing anti-MAIAP antibody in a subject”. Support for this amendment is found in the specification on p. 33, lines 7-19.

Rejections

Claim Objections

1. Claim 20 is cancelled. Claims 18, 21 and 50 have been amended to claim only SEQ ID NO:11, deleting reference to other non-elected inventions and species. Claims 18 and 50 have been amended to specifically recite “the MAIAP SEQ ID NO: 11” for

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reasons of clarity. Thus, Claims 21 (which depends from claim 18) and 50 now recite SEQ ID NO: 11 in the context of the MAIAP nucleic acid. Applicants respectfully submit that all claim objections have been addressed and should be removed.

Claim Rejections under 35 USC § 101 -- Non-Statutory Subject Matter

Claim 23 has been amended to recited “an isolated cell”. Applicants thus submit that claim 23 is directed to patentable subject matter, and so request withdrawal of the § 101 rejection.

Claim Rejections under 35 USC § 112, para. 2 -- Indefiniteness

Claims 20, 59 and 60-62 have been cancelled. Applicants therefore submit that these rejections are moot and should be withdrawn.

Claim Rejections under 35 USC § 112, para. 1 -- Written Description and Enablement

Claims 20 and 57-62 have been cancelled. Claims 18 and 50 have been amended to recite that the nucleic acid is specifically the MAIAP nucleic acid SEQ ID NO: 11. Applicants therefore respectfully submit that the pending claims meet the written description requirements and are enabled, and request that the rejections based on written description and enablement be withdrawn.

Rejections under 35 USC § 102(e)

Claims 20-23, 50-52 and 57-62 stand rejected as anticipated by US 6,472,172. However, in light of the amendments to the claims to recite SEQ ID NO: 11, Applicants respectfully submit that US 6,472,172 does not anticipate the presently claimed invention. Withdrawal of the anticipation rejections is therefore requested.

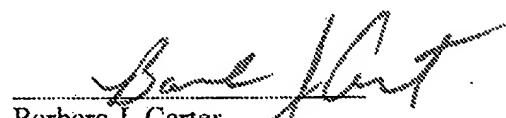
Applicants respectfully submit that all claims are in condition for allowance. Reconsideration of the application and issuance of a notice of allowance are therefore respectfully requested.

Applicants believe that only a one-month extension of time is required; however, in the event that the need for an additional extension under 37 C.F.R. §1.136 has been overlooked, Applicants hereby submit this conditional petition for an additional extension

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of time. The applicant believes that \$60 in fees to cover the one-month extension are due at this time; however if additional fees are due for the timely consideration of this application, please charge deposit account number 19-4972. The Examiner is requested to telephone the undersigned if any outstanding issues remain, so that these matters may be resolved expeditiously.

Respectfully submitted,



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